

U.S. Serial No. 09/470,026

Response to Office Action dated March 29, 2004

REMARKS

Applicants have carefully reviewed the office action dated March 29, 2004. Claims 1-21, 30, 36, 42-46, and 50-56 are pending. Claims 1-20, 30, 36 and 42 have been withdrawn from consideration. Claims 21, 43-46, and 50-54 have been rejected, and claim 21 has been amended. New claims 55 and 56 have been added.

Claims 21 and 50-54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nash et al., U.S. Patent 6,080,170 (hereinafter Nash) in view of Muni, U.S. Patent 6,135,991 (hereinafter Muni). Applicants respectfully traverse this rejection. In order for a combination of references to render a claim obvious, there must be some motivation in the prior art to combine the references. See M.P.E.P. §2143.01. The method in claim 21, as amended, recites the simultaneous infusion and aspiration of fluid and the presence of one or more infusion ports on the outer surface of the aspirating catheter. The language of claim 21 also shows that the aspirating catheter comprises both the aspirating and infusion elements.

There are at least two advantages over the prior art of the configuration recited in claim 21, and neither of these advantages is mentioned in the cited prior art. First, having the infusion ports on the outer surface of an elongate member allows the center of the elongate member to be kept open for other uses. For example, Figures 1 and 8 show a balloon catheter and a stent delivery catheter, respectively, being passed down the center of aspiration catheter 30. When the infusion ports are disposed on the outer perimeter of the aspirating device as in the examples given in the specification, the operator of the device can continue performing aspiration/infusion while introducing and/or operating another device through the aspirating catheter. Thus, more aspiration/infusion can be done because the simultaneous aspirating/infusion can be performed throughout the entire procedure. This advantage can

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also lead to shorter total procedure times. Neither cited reference mentions this combination or the motivation for making such a combination.

At the same time, the method of claim 21 can allow the simultaneous infusion and aspiration of fluid to be directed in a path immediately along the vessel walls because the infusion ports can be placed along the vessel walls. In this way, a greater amount of embolic material can be effectively and quickly removed. Neither of the references provides this motivation. Applicants respectfully assert that claim 21 is patentable over Nash in view of Muni because the motivation for combining these references is not present in the prior art. Because they are dependent on allowable claim 21 and because they contain additional patentably distinct elements, claims 50-54 are also allowable.

Claims 43-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nash in view of Imran, U.S. Patent 5,833,650 (hereinafter Imran). Applicants respectfully traverse this rejection. In order for prior art to render a claim obvious, all of the elements of the claim must be taught or suggested in the prior art. *See* M.P.E.P. §2143.03. Nash does not disclose at least one element of independent claim 21. Specifically, Nash does not disclose the infusion of fluid through infusion ports located on the side of the aspirating catheter. In addition, Imran does not supply this missing element. Because they are dependent on claim 21 and because they contain additional patentably distinct elements, all elements of claims 43-46 are not disclosed in the cited prior art. Applicants respectfully assert that dependent claims 43-46 are patentable over Nash in view of Imran.

Finally, because newly presented claims 55 and 56 are dependent on allowable claim 21, and because they recite additional patentably distinct elements, Applicants assert that they

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are also allowable. One area of support in the specification for these newly presented claims is on page 9, line 21 through page 10, line 11 and in Figure 1.

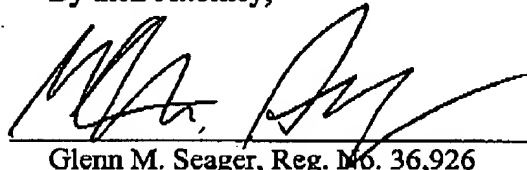
Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

YUE-TEH HANG ET AL.

By their Attorney,

Date:

June 29, 2004

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